

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

WILLIAM PATRICK APPS

Group Art Unit: 3727

Examiner: S. Castellano

Serial No.: 09/785,100

Filed: February 15, 2001

For: NESTABLE DISPLAY CRATE FOR BOTTLE CARRIERS

Attorney Docket No.: RPC 0559 PUS

**REQUEST FOR RECONSIDERATION
AND CLARIFICATION**

Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

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AND INTERFERENCES

Appellant requests reconsideration of the Decision on Appeal mailed August 31, 2005. In large part, the Board's Decision was based upon rationale not advanced by the Examiner, and thus not fully addressed by Appellant's Appeal Brief and Reply Brief.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, (in triplicate) is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Board of Patent Appeals and Interferences, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on:

October 31, 2005
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Robert C. Brandenburg
Name of Person Signing


Signature

In the August 31, 2005 Decision, the Board issued its Decision on Appeal upholding the Examiner's decision rejecting the claims on appeal under §§ 102(b) and 102(e). An issue on appeal was what constituted "bottle carriers". The Board stated on page 2:

Although the specification does not define the meaning and scope of "bottle carriers," it states that "bottles are grouped together in a cardboard carrier or otherwise bundled. . . ." and that a shrink wrap can be used as a carrier. See the specification, page 2. Thus, we determine that the term "bottle carriers" encompasses a conventional thin plastic web material having circular-shape holes (ring carrier) for bundling and transporting multiple bottles and/or any other bottle carriers, including those which conform to the shapes of the interior surfaces of the prior art creates relied upon by the examiner. In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.").

During the Decision, the Board also addressed the issue of double patenting in Footnote 2 which read:

Without properly comparing the claims involved, the examiner has withdrawn the obviousness-type double patenting rejections based on Apps '654 and Apps '012. In the event of further prosecution, the examiner should reintroduce the obviousness-type double patenting rejection of **at least** claims 1 and 2 of the present application based on claims 1 and 2 of Apps '654. Claims 1 and 2 of Apps '654 anticipate the subject matter recited in at least claims 1 and 2 of the present application since claims 1 and 2 of the present application do not preclude, for example, the double thickness wall structure recited in Apps '654. Moreover, unlike Carman Indus. Inc. v. Wahl, 724 F.2d 932, 939-40, 220 USPQ 481, 487 (Fed. Cir. 1983), claims 1 through 51 of the present application are directed to the design of a crate, which is identical to those shown and claimed in Apps '012. It appears that claims 1 through 51 as a whole would have taught or suggested the design illustrated and claimed in Apps '012 and the claim of Apps '012 anticipates the subject matter recited in claims 1 through 51 of the present application.

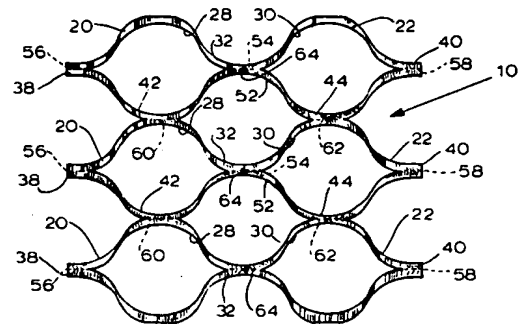
It is respectfully submitted that these findings constitute new grounds of rejection under 37 USC § 1.196.

**I. Reliance Upon Ring Carrier “Bottle Carriers”
Does Not Justify Rejection Of The Claims As Anticipated.**

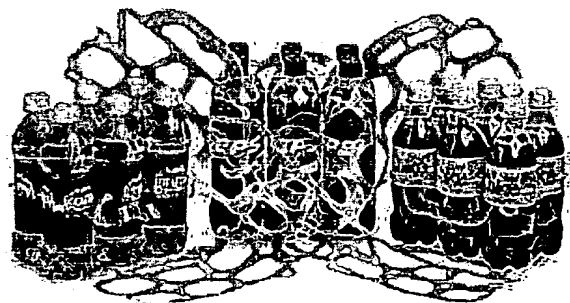
According to the Decision, bottle carriers in the form of “ring carriers” provide the basis for the anticipation of the claims. The Board’s reliance on ring carriers as the bottle carriers to be used in the claims is the first reference to ring carriers in the prosecution of this case. The Board’s Decision constitutes new grounds of rejection warranting re-hearing.

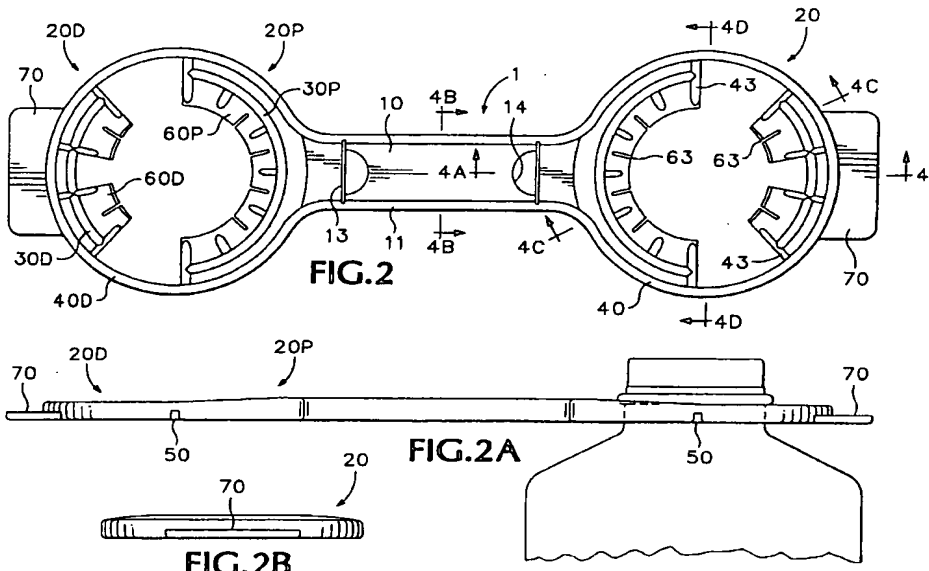
Further, the “ring carriers” are not defined by the Board beyond its statement that they are “a conventional thin plastic web material having circular-shape holes (ring carrier) for bundling and transporting multiple bottles and/or any other bottle carriers.” (Decision, p. 2.) There are a number of ring carriers in the art and it is not clear to which the Board refers. However, there are at least two general groupings of ring carriers. The first is typified by U.S. Patent No. RE 29,873 is a thin plastic cut to form openings for placement around the sides of the containers to be held. The patent shows ring carriers for cans, but mentions their use for bottles. (See, col. 2, ll. 40-49.) Shown is a picture of similar ring carriers for bottles taken from the Mumm Products website found at

(www.sixpackrings.com/2005%20Site/Web%20Pages/Bottle%20Carriers.htm)



RE 29,873, FIG. 2





U.S. Patent No. 5,735,562

The second is typified by U.S. Patent No. 5,735,562. These carriers encircle and hold the tops of bottles.

Since the Board was not clear as to the precise nature of the bottle carriers, both

these types of carriers will be addressed and shown how they do not support the anticipation of the claims.¹

Turning to the anticipation of Claim 1 and its dependent Claim 2, Claim 1 requires "display openings [that] are sized to reveal labels on the bottle carriers for displaying the bottle carriers in a loaded crate" Ring carriers are not designed to carry labels and certainly the positioning of the ring carriers on the top portion of the bottles does not allow the ring carriers, let alone their non-existent labels, to be revealed in the display openings of the cited prior art.

Claim 15 and its dependent Claim 16 and Claim 28 and its dependent Claim 33 all have the same unmet requirement.

Further, a ring carrier of the type that holds the opening of the bottle, such as in the '562 patent will not have the various bottle carrier support surfaces called for in the

¹ Only the representative claims are addressed in this paper, but the arguments are proper for all the pending claims.

claims since the ring carrier lies above and does not contact the crate. See, Claim 1 (“a floor for supporting the bottle carriers,” “interior bottle carrier support surfaces”), Claim 2 (“said teeth panels being flat to provide lateral support to the bottle carriers loaded in said crate”), Claim 15 (“a floor having an upper surface for supporting the bottle carriers,” “interior bottle carrier support surfaces”), Claim 16 (“said teeth panels being flat to provide lateral support to the bottle carriers loaded in said crate”), Claim 28 (“a floor having an upper surface for supporting the bottle carriers”) and Claim 33 (“said teeth panels being flat to provide lateral support to the bottle carriers”).

The ring carrier of the type that holds the sides of the bottles may be positioned low on the bottles so to be within the crate, but this would be an inappropriate positioning of the ring carriers. The lower the positioning of the ring carrier, the less stable the bottles when carried. However, even if so positioned, the crate would not have “a floor having an upper surface for supporting the bottle carriers” as is required by all the claims. Further, it is not seen how the requirement of Claims 2, 16 and 33 are met in that the teeth panels would not provide lateral support to the bottle carriers.

The ring carriers shown above do not anticipate the claims of the application. The ruling of anticipation should be withdrawn. Clarification and a chance to further respond is requested, if the Board had envisioned a ring carrier of a type not discussed.

II. The Double Patenting Discussion Should Be Withdrawn or Designated As Dicta.

The Appellant understands footnote 2, discussing double patenting, is mere dicta and not a binding ruling of the Board. As such it is asked that it be withdrawn so as not to confuse the record. If intended as a substantive rejection, it constitutes new grounds of rejection since the Examiner withdrew all reliance on double patenting as a ground for rejection and had not, as mentioned in the footnote, properly compared the claims involved.

The existence of this footnote confuses the record and suggests double patenting exists without what Appellant believes is the required detailed analysis. For example, it is unclear to which claims are properly subject to a double patenting rejection based on Apps '654 utility patent, due to the "at least" language. This lack of specificity limits a proper understanding of the rejection and how to respond.²

More importantly, the suggestion that there is a double patenting rejection based on the Apps '012 design patent is improper under the law. It is clear that the design patent claim need not read on an invention embodying that claimed in the application as required for design-utility double patenting.

"The law provides that, in some very rare cases, obvious-type double patenting may be found between design and utility patents. *See Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 939-40, 220 USPQ 481, 487 (Fed. Cir. 1983) (noting that, while theoretically possible, '[d]ouble patenting is rare in the context of utility versus design patents'); *In re Thorington*, 418 F.2d 528, 536-37, 163 USPQ 644, 650 (CCPA 1969) (Double patenting between a design and utility patent is possible 'if the features producing the novel aesthetic effect of a design patent or application are the same as those recited in the claims of a utility patent or application as producing a novel structure.'). In these cases, a 'two-way' test is applicable. *See Carman*, 724 F.2d at 940, 220 USPQ at 487. Under this test, the obviousness-type double patenting

² It is Appellant's intent to file a terminal disclaimer on the utility double patenting rejection.

rejection is appropriate only if the claims of the two patents cross-read, meaning that ‘the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa.’ Id., 220 USPQ at 487.” *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

The claims of the current application can cover multiple embodiments. For example, one can envision sufficient changes, including the shape (e.g., making it square), details of the bottom, positioning of the handle (e.g., on the long side) and other changes, which when taken together would create a different design, but would still be covered by the application.³ Thus, like the claims in *Dembiczak*, the pending claims in this utility patent application do not render the design patent obvious.

Thus, it is asked that all references to double patenting be withdrawn from the Decision.

³ In fact, the Board in its Decision held all the claims were anticipated by Apps ‘462, a significantly different design.

CONCLUSION

Therefore, it is asked that the Board reconsider and clarify its Decision and allow all the pending claims.

Respectfully submitted,
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Date: October 31, 2005

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